

REMARKS

The present Amendment responds to the Office Action dated October 12, 2007. The Examiner set a shortened statutory period for reply of three (3) months, making the present Amendment due by January 12, 2008, which is a Saturday, such that the present response is timely if filed by Monday, January 14, 2008.

In the Office Action, claims 1-4 are pending. The Examiner rejected each of the pending claims under 35 U.S.C. § 112, second paragraph. More particularly, the Examiner takes the position "the term 'the two-component mixture of metamifop with benzobicyclon being excluded' is confusing." The Examiner will note that claim 1 has been amended such that this term no longer appears in the claim. Applicant believes that amending claim 1 in this way addresses each of the Examiner's § 112, second paragraph rejections.

The Examiner has also rejected each of the claims under 35 U.S.C. § 103(a) as being unpatentable over WO 00/05956 to Kim et al. As the Examiner states in the Office Action, Kim et al. teach the compound metamifop and that the herbicide can be used alone or in combination with other herbicides, insecticides, or bactericides. However, as the Examiner also states, the Kim et al. reference "does not teach the specific synergistically effective compounds or combinations disclosed in claims 1 and 2 (component b))." (emphasis added). From this, the Examiner concludes

it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Kim et al. to further include the herbicides disclosed in claims 1 and 2. One would have been motivated to include these herbicides because some are also sulfonylurea herbicides (sulfosulfuron, iodosulfuron, imazosulfuron, etc.) used in the art of the same purpose and different combinations of herbicidal formulations are desirable to decrease resistance.

(O.A., p. 4).

Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness in rejecting the claims in view of the Kim et al. reference and requests withdrawal of the claim rejections in view of the arguments made below. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), Section 2141 (III) of the MPEP provides, in part,:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396, Sept. 2007 2100-128 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*,

441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

In the Office Action, the Examiner seems to simply conclude that because Kim et al. teach that the herbicidal compounds of formula (1)¹, such as metamifop, can be combined with another herbicide, that one of ordinary skill in the art would be led to combine metamifop and S-metolachlor. Applicant notes that the Examiner has specifically acknowledged that none of the herbicides originally claimed in claims 1 and 2 (component b)) are listed on page 21 of the Kim et al. reference. More particularly, in view of the current amendment to claim 1, Applicant highlights that the Kim et al. reference does not teach mixing metamifop with any chloroacetanilides, let alone S-metolachlor. Applicant is unclear from the Examiner's Office Action as to how one of ordinary skill in the art would be led, or otherwise motivated by Kim et al., to specifically combine metamifop and S-metolachlor. Accordingly, Applicant takes the position that the Examiner has improperly supported the § 103(a) rejection of the claims as it appears to lack "an articulated reasoning with some rational underpinning to support the legal conclusion of obviousness", as set forth in Section 2141 (III) of the MPEP.

Secondly, a closer look at the cited reference clearly shows that the list of mixing partners disclosed in Kim et al. are "essential" to the compounds of formula (1). On page 21, Kim et al. teach "[e]specially it is essential to add one or more agents selected from the group consisting of...." (p. 21, lines 20-21) (emphasis added). Applicant takes the position that one of ordinary skill in the art would understand that these thirty-five (35) agents specifically listed on page 21 are a requirement for the utility of these herbicidal compounds, such as metamifop. Applicant submits that this essential list of agents discourages one of ordinary skill from seeking alternative mixing partners. Accordingly, the cited reference *teaches away* from Applicant's claimed invention.

Finally, Kim et al. do not teach, or even suggest, finding a suitable mixing partner for the disclosed compounds of formula (1) that would form a synergistic composition, as claimed in the present application. Indeed, there is no mention of synergy in the Kim et al. reference. Since Kim et al. are silent as to synergistically increasing the effects of the herbicidal phenoxypropionic acid N-alkyl-N-2-fluororphenyl amides, one of ordinary skill in the art would not be motivated to stray outside of the essential list of agents to then find a mixing partner, such as S-metolachlor, that would exhibit a synergistic action the targeted weeds.

¹ The Kim et al. reference discloses the herbicidal phenoxypropionic acid N-alkyl-N-2-fluororphenyl amides of formula (1), on page 1.

Based upon the foregoing arguments, Applicant submits that the Examiner's *prima facie* case of obviousness is supported by a general, conclusory statement, and is therefore an improper rejection of the pending claims. In addition, Applicant argues that Kim et al. teach away from the claimed invention because the reference teaches that it is essential to combine the herbicidal compounds of formula (1) with a very specific list of agents, none of which include any chloroacetanilides, let alone S-metolachlor. Finally, Applicant argues that the Kim et al. reference, alone, could not motivate one of ordinary skill in the art to explore mixing partners that would exhibit synergistic action. The requisite motivation to first step outside of the list of essential agents to then combine metamifop and S-metolachlor for the purpose of exceeding the additive effect of those active ingredients on the weeds cannot conceivably be derived from the Kim et al. disclosure without resorting to hindsight reasoning, which is impermissible in establishing a *prima facie* case of obviousness.

Based upon the foregoing then, Applicant submits that the pending claims are in condition for allowance and the Examiner is courteously solicited to pass this application on to allowance. No other fees are believed to be payable at this time. However, the Commissioner is authorized to debit any applicable fees from the deposit account of the undersigned, no 50-1676 in the name of Syngenta Crop Protection, Inc.

Respectfully submitted,

USPTO Customer No. 26748
Syngenta Crop Protection, Inc.
Patent and Trademark Dept.
410 Swing Road
Greensboro, NC 27409
(336) 632-6049

/Rebecca A. Howard/
Rebecca A. Howard
Attorney for Applicants
Reg. No. 51,724

Date: January 14, 2008